

II. REMARKS

By the present amendment, claim 6 has been amended to recite “said end orifice extending in a plane parallel to that of the strand for receiving said bar” and “the elongated hole through which the cutting has been made becomes a new end notch for receiving the eyelet part of the tongue” as supported on page 3, lines 12-14, page 4, lines 8-11, and Figure 3 of Applicant’s disclosure as originally filed.

The present amendment adds no new matter to the above-captioned application.

A. The Rejection

Claims 6-12 stand rejected under 35 U.S.C. § 103(a) as unpatentable over Rhea (U.S. Patent 4,470,174, hereafter the “Rhea Patent”).

Applicant respectfully traverses the rejection and requests reconsideration of the above-captioned application for the following reasons.

B. Applicant’s Arguments

A prima facie case of obviousness requires a showing that the scope and content of the prior art teaches each and every element of the claimed invention, and that the prior art provides some teaching, suggestion or motivation, or other legitimate reason, for combining the references in the manner claimed. KSR International Co. v. Teleflex Inc., 127 S.Ct. 1727, 1739-41 (2007); In re Oetiker, 24 U.S.P.Q.2d 1443 (Fed. Cir. 1992). In this case, the Examiner has not established a prima facie case of obviousness against the claimed invention because the Rhea Patent does not teach each and every element of the claimed invention.

i. The Rhea Patent

The Rhea Patent discloses an “adjustable fastener” (10), as shown in Figures 1, 12 and 13, that includes a strap (11) having a first portion (14) and a second portion (15) and a plurality of holes (17) in the first portion of the strap and a yoke (32) having a hook portion (39) and a clasp portion (42) and a hole (35) adjustably coupled to the first portion of the strap and engagement means (65) coupled to the second portion of the strap capable of engaging the yoke and disengaging from the yoke (See Abstract of the Rhea Patent).

However, the Rhea Patent does not teach, or even suggest, (i) “the first strand having an end orifice arranged transversely close to a free end of the strand, said end orifice extending in a plane parallel to that of the strand for receiving said bar” as recited by independent claim 6. The Examiner contends that holes (28) and (30), as illustrated in Figure 1 of the Rhea Patent (reproduced below for convenience), are “end orifices” (Office Action, dated October 17, 2008, at 3, lines 1-2). The Rhea Patent plainly discloses that holes (28),

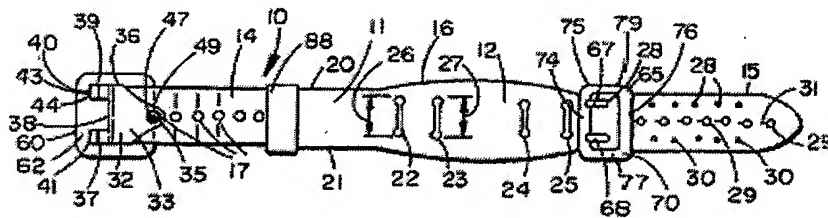


Figure 1 of Rhea Patent

(30) are used as holes in which hooks (67) and (68) are inserted (See Rhea Patent, col. 5, lines 18-20, and Figures 17, 20 and 23). The Rhea Patent does not teach, or suggest, that bar (66) is inserted into the holes (67), (68). Therefore, the Examiner’s contention is flawed. A person of ordinary skill in the art would instantly appreciate from Figure 1 of the Rhea Patent that holes (28) and (30) extend in a plane that is perpendicular to the plane of strap second

portion (15). Furthermore, a person of ordinary skill in the art would realize that the holes (28) and (30) are not used for receiving the bar (66) of the buckle (79).

In sum, the Rhea Patent discloses that holes (28), (30) receive hooks (67), (68) and not bar (66); therefore, the Rhea Patent does not teach, or suggest, “the first strand having an end orifice arranged transversely close to a free end of the strand, said end orifice extending in a plane parallel to that of the strand for receiving said bar” as recited by independent claim 6. This, however, is not the only deficiency in the disclosure of the Rhea Patent. The Rhea Patent also does not teach, or suggest, (ii) “an end notch extending from said free end to beyond the end orifice to receive the eyelet part of the tongue” and (iii) “the elongated hole through which the cutting has been made becomes a new end notch for receiving the eyelet part of the tongue” as recited by independent claim 6.

The Examiner erroneously contends that the Rhea Patent discloses an “end notch” provided by hole (29) shown in Figure 1 (Office Action, dated October 17, 2008, at 3, lines 2-3). The Examiner’s contention is facially flawed because it is the holes (28) and (30) that receive hooks (67) and (68) according to the Rhea Patent. As disclosed by the Rhea Patent, at col. 8, lines 32-36, the hole (29) is provided in the strap second portion (15) to receive stud (49) provided in the strap first portion (14), (See also Figure 10 of the Rhea Patent). The Rhea Patent does not teach, or suggest, that hole (29) is “an end notch” extending from the free end to beyond the end orifice to receive the eyelet part of the tongue of buckle (79).

A person of ordinary skill in the art would realize that the “buckle” in accordance with Applicant’s claimed invention can only be attached to the very end of the “strand” because the end orifice extends in a plane parallel to that of the strand and to the end notch receiving the eyelet part of the tongue. The strap disclosed by the Rhea Patent, on the other hand, permits the buckle (79) to be attached anywhere along the strap second portion (15) where there are holes (28) and (30). As shown by Figure 1 of the Rhea Patent, there are no

holes (28), (30) at the very end of strap second portion (15) so it is not possible to attach the buckle (79) to the very end of the strap second portion (15). Therefore, a person of ordinary skill in the art would immediately realize that the Rhea Patent does not teach, or suggest, “an end notch extending from said free end to beyond the end orifice to receive the eyelet part of the tongue” as recited by claim 6.

As admitted by the Examiner (Office Action, dated October 17, 2007, at 3, lines 8-11, the Rhea Patent does not teach, or suggest, (iv) “the first strand can be shortened by cutting along a transverse section passing through any one of said elongated holes, the transverse orifice associated with the hole becoming a new end orifice for receiving said bar.” The Examiner contends that the Rhea Patent discloses a “cutting feature” with respect to the strap first portion (14) and not the strap second portion (15); however, the Examiner argues that it would have been obvious to move the “cutting feature” from the first portion (14) to the second portion (15) in the absence of any criticality (Office Action, dated October 17, 2007, at 3, line 11, to 4, line 9). In support of the Examiner’s conclusion, the Examiner cites In re Japikse, 86 U.S.P.Q. 70 (C.C.P.A. 1950).

The Examiner has misapplied the Japikse decision for the following reasons. The court in Japikse held that it would have been obvious to have moved a “starting switch” disclosed by a prior art circuit to another position because the operation of the device would not be modified by the change in position of the starting switch. In re Japikse, 86 U.S.P.Q. at 73. The court in Japikse did not rule so broadly, as the Examiner contends, as to require that the change in position of components be “critical” to the invention. The court in Japikse held only that it would be obvious to modify a prior art device in a manner that would not modify its operation.

In the present case, modifying the device disclosed by the Rhea Patent so that the “cutting feature” would be on the strap second portion (15) instead of on the strap first

portion (14) would have a profound detrimental effect on the operation of the Rhea strap.

The Rhea Patent discloses changing the location of yoke (32) by cutting the strap first portion (14) and inserting the stud (49) in a different one of the holes (17), (col. 6, line 54, to col. 7, line 3). Thus, the adjustable feature provided by the strap of Rhea is due to moving the location of yoke (32) along the strap first portion (14).

The modification proposed by the Examiner would profoundly modify the strap disclosed by the Rhea Patent so that the adjustable feature would depend upon shortening the strap second portion (15), which would render the holes (17) of the strap first portion (14) superfluous. Furthermore, the adjustability of the buckle (79) along the second strap portion (Rhea Patent, col. 5, lines 49-61) would be compromised, as would be instantly understood by a person of ordinary skill in the art, because the strap second portion (15) would be cut shorter if the modification proposed by the Examiner were made. Thus, there would be fewer objects that the strap could be used for because there would be less holes (28), (30) into which to place hooks (67) and (68) once strap portion (15) is shortened. A person of ordinary skill in the art would, therefore, understand that the modification proposed by the Examiner would detrimentally effect the adjustability of the strap (11).

In view of the above facts, the rule in Japikse cannot be applied in this case because moving the “cutting feature” from first portion (14) to second portion (15) the buckle (79) would diminish adjustability of the strap (11) so that it would not be useable with as many objects. The rule in Japikse only applies to situations where the proposed modification of a prior art device has no effect on the operability of the device and, therefore, cannot be applied to the Examiner’s proposed detrimental modification that would profoundly hinder the adjustability of strap (11).

The Examiner’s proposed modification is also not obvious because the Federal Circuit has held that a prima facie case of obviousness cannot be predicated on a modification of the

prior art that would render a device inoperable, In re Gordon, 221 U.S.P.Q. 1125, 1127 (Fed. Cir. 1984), or that would obliterate an essential feature, McGinley v. Franklin Sports Inc., 60 U.S.P.Q.2d 1001, 1010 (Fed. Cir. 2001). In this case, moving the “cutting feature” from first portion (14) to second portion (15) of Rhea’s strap (11) would obliterate an adjustability feature of the strap that is provided by allowing the buckle (79) to be employed in different holes (28), (30) along the second portion (15). Consequently, the Examiner’s proposed modification of the device disclosed by the Rhea Patent is not obvious in view of the Federal Circuit’s rulings in In re Gordon and McGinley v. Franklin Sports Inc.

In addition, a person of ordinary skill in the art would also immediately realize that changing the location of the cutting feature disclosed for the strap first portion (14), (See, Rhea Patent at col. 6, line 62, to col. 7, line 3), to strap second portion (15) as the Examiner contends (Office Action, dated October 17, page 3, line 14, to page 4, line 9), would still not lead to a stand having “said end orifice extending in a plane parallel to that of the strand for receiving said bar,” and “the elongated hole through which the cutting has been made becomes a new end notch for receiving the eyelet part of the tongue” of the buckle, as recited by independent claim 6.

For all of the above reasons, the Examiner has failed to establish a prima facie case of obviousness against independent claim 6.

III. CONCLUSION

The Examiner’s rejection under 35 U.S.C. § 103 is plainly untenable and must be withdrawn because the Rhea Patent fails to disclose multiple limitations of independent claim 6 including (i) “the first strand having an end orifice arranged transversely close to a free end of the strand, said end orifice extending in a plane parallel to that of the strand for receiving said bar,” (ii) “an end notch extending from said free end to beyond the end orifice to receive

the eyelet part of the tongue,” (iii) “the elongated hole through which the cutting has been made becomes a new end notch for receiving the eyelet part of the tongue,” and (iv) “the first strand can be shortened by cutting along a transverse section passing through any one of said elongated holes, the transverse orifice associated with the hole becoming a new end orifice for receiving said bar.” Furthermore, the Examiner’s proposed detrimental modification of the strap disclosed by the Rhea Patent lacks a proper teaching, suggestion, motivation, or other legitimate reason because moving the “cutting feature” from strap first portion (14) to strap second portion (15) would profoundly modify the operation of the strap so that the rule in Japikse cannot be properly applied, and because the modification would obliterate an essential adjustability feature provided by the buckle (79) and strap second portion (15) thereby invoking the Federal Circuit’s holdings in In re Gordon and McGinley v. Franklin Sports Inc., which do not permit detrimental modifications of prior art devices to establish a prima facie case of obviousness.

For all of the above reasons, claims 6-12 are in condition for allowance and a prompt notice of allowance is earnestly solicited.

Questions are welcomed by the below-signed attorney for Applicant.

Respectfully submitted,

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